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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/705,575 11/03/00 LAWTON

E 1596C9

024959 IM22/1003
PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
ONE PPG PLACE
PITTSBURGH PA 15272

EXAMINER

GRAY, I

ART UNIT

PAPER NUMBER

1774
DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/705,575

Applicant(s)

LAWTON ET AL

Examiner

Jill Gray

Art Unit

1774



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the references to copending and parent applications must include the current status, whether patented or abandoned.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for demonstrating superior results using boron nitride having the claimed critical properties as the inorganic particle, does not reasonably provide enablement for unexpected or superior results when any inorganic particle as embraced by the claims having a hardness value which does not exceed a hardness value of the at least one glass fiber. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. More specifically, there is no clear support in the specification that any inorganic particle having a hardness value which does not exceed a hardness value of the at least one glass fiber would result

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in superior or unexpected results in the end fabric product. It is noted that applicants are not required to provide examples of each and every embodiment claimed, however, there should be reasonable disclosure that is commensurate with the scope of the claimed subject matter. The present specification compares one inorganic particle material having a specific hardness value, and, there is no clear support in the specification any inorganic particle within the broad range set forth by applicants would in fact function as intended by applicants.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Terpay, 4,282,011.

Terpay teaches a fabric comprising a coated fiber strand comprising an aqueous coating applied to at least a portion of one glass fiber, as required by the claims, said coating comprising a polymeric material such as epoxy or acrylic polymers, as set forth by applicants and contains particles of the type contemplated by applicants in claim 9, wherein properties such as the Mohs' hardness and thermal conductivity are inherent. In addition, Terpay teaches that his composition contains a resin reactive diluent. See column 4, lines 13-35.

Therefore, the prior art teachings of Terpay anticipate the present claimed invention of claims 1-9, and 18-27.

5. Claims 1, 3, 8-20, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Philips et al, 3,312,569 (Philips).

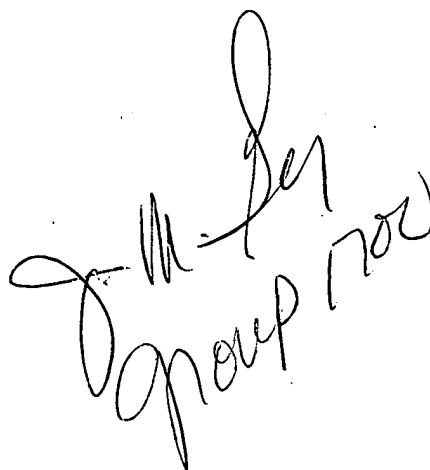
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Philips teaches glass fibers in the form of fabrics, comprising a coated fiber strand comprising at least one glass fiber having a primary layer of a sizing composition applied thereto, as required by applicants in claims 1, 3, and 29. The sizing composition comprises inorganic solid particles of the type contemplated by applicants, wherein properties such as the Mohs' hardness and thermal conductivity are inherent. In addition, Philips teaches that his aqueous sizing composition contains a polymeric material of the sort set forth by applicants, and has a resin reactive diluent as required by applicants.

Therefore, the prior art teachings of Philips anticipates the invention as claimed in claims 1-9 and 18-27

No claims are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. M. Gray whose telephone number is (703) 308-2381.

A handwritten signature in cursive script, reading "J. M. Gray" followed by "group 1700" written below it.

jmg

October 1, 2001